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In re Application of

LIPOVSKII et al.

Application No.: 10/501,953

PCT No.: PCT/IL03/00055

Int. Filing Date: 22 January 2003

Priority Date: 22 January 2002

Attorney Docket No.: P-7008-US

For: POTASSIUM FREE ZINC SILICATE

GLASSES FOR ION-EXCHANGE PROCESSES

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DECISION ON REQUEST
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UNDER 37 CFR 1.497(d)
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This is a decision on applicants' "Petition to Add Inventor(s) Under 37 CFR 1.48", filed on 21 July 2004 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Eli Arad as inventor in the above referenced application. The requisite \$130 petition fee was paid. The petition is being treated as a petition under 37 CFR 1.497(d).

BACKGROUND

On 21 July 2004, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. Applicant also filed a petition under 37 CFR 1.48 for correction of inventorship, to add Eli Arad as an inventor. In addition to the \$130 petition fee, Petitioner provided the statement of the inventor Mr. Arad in support of the correction of inventorship under 37 CFR 1.497(d). Petitioner indicates that "the consent of the assignee is not required insofar as no assignment has yet been executed." An declaration executed by the joint inventors was not submitted.

DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor . . . that any error in inventorship in the international application

occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(I); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Applicants provided a statement, signed by Eli Arad, stating that "My name, ARAD, Eli, was inadvertently omitted from the list of inventors, without deceptive intent on the part of the undersigned". This statement satisfies item (1) of 37 CFR 1.497(d).

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), a review of the application file reveals that an assignment of assignors interest was filed with the USPTO on 29 December 2004. Applicant has not provided a "Written Consent of Assignee in Correction of Inventorship under 37 CFR 1.497(d)(3)" and a statement under 37 CFR 3.73(b) consenting to the addition of Eli Arad as an inventor in this application.

Accordingly, applicant has not met all of the requirements to add Eli Arad as co-inventor in the above-identified international application.

CONCLUSION

The request under 37 CFR 1.497(d) to add Eli Arad is **DISMISSED WITHOUT PREJUDICE**. Applicant has **TWO (2)** months to file a response. Extensions of time may be obtained under 37 CFR 1.136(a). The application will be held in the PCT Legal Office to await the proper reply.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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